

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Yang *et al.*

Appl. No.: 09/677,574

Filed: October 3, 2000

For: **High Fidelity Polymerases and
Uses Thereof**

Confirmation No.: 1982

Art Unit: 1652

Examiner: Hutson, Richard G.

Atty. Docket: 0942.4500004/BJD/HCC

Fifth Supplemental Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. The numbering on this Fifth Supplemental Information Disclosure Statement is a continuation of the numbering in Applicants' Fourth Supplemental Information Disclosure Statement filed on December 17, 2003 in connection with the above-captioned application.

Applicants would like to bring to the Examiner's attention cited Office Actions (Documents AS51-AS54) from the following co-pending applications which are directed to related technical matter:

U.S. Patent Application No. 08/526,759, Chatterjee, D.K., filed December 26, 1995;

U.S. Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000;

The identification of these Office Actions is not to be construed as a waiver of secrecy as to the corresponding applications now or upon issuance of the present

application as a patent. The Examiner is respectfully requested to consider the cited Office Actions during prosecution of these applications.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

Applicants have checked the appropriate boxes below.

- ☐ 1. Statement under 37 C.F.R. 1.704(d). Each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this information disclosure statement.
- ☐ 2. Filing under 37 C.F.R. § 1.97(b). This Information Disclosure Statement is being filed within three months of the date of filing of a national application other than

a continued prosecution application (CPA), OR within three months of the date of entry of the national stage as set forth in 37 C.F.R. § 1.491 in an international application, OR before the mailing date of a first Office Action on the merits OR before the mailing of a first Office Action after the filing of a request for continued examination under 37 C.F.R. § 1.114. No statement or fee is required.

- ☒ 3. Filing under 37 C.F.R. § 1.97(c). This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application.
- ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
- ☒ c. Attached is our PTO-2038 Credit Card Payment Form in the amount of \$180.00 in payment of the fee under 37 C.F.R. § 1.17(p).

- ☐ 4. Filing under 37 C.F.R. § 1.97(d) This Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of a Final Rejection or Notice of Allowance, but before payment of the Issue Fee. Enclosed find our PTO-2038 Credit Card Payment Form in the amount of \$_____ in payment of the fee under 37 C.F.R. § 1.17(p); in addition:
- ☐ a. Statement under 37 C.F.R. § 1.97(e)(1). I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(1).
- ☐ b. Statement under 37 C.F.R. § 1.97(e)(2). I hereby state that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 C.F.R. § 1.97(e)(2).
- ☐ 5. The document(s) was/were cited in a search report by a foreign patent office in a counterpart foreign application. Submission of an English language version of the search report that indicates the degree of relevance found by the foreign office is provided in satisfaction of the requirement for a concise explanation of relevance. 1138 OG 37, 38.
- ☐ 6. A concise explanation of the relevance of the non-English language document(s) appears below:
- ☒ 7. Copies of the documents are submitted herewith.

- ☐ 8. Copies of the documents were cited by or submitted to the Office in an IDS that complies with 37 C.F.R. § 1.98(a)-(c) in Application No. _____, filed _____, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).
- ☐ 9. No copies of U.S. patents and patent application publications cited on the attached Form PTO-1449 are submitted in accordance with 1276 OG 55 because this application was filed after June 30, 2003.
- ☒ 10. It is expected that the examiner will review the prosecution and cited art in the parent applications in accordance with MPEP 2001.06(b), and indicate in the next communication from the office that the art cited in the earlier prosecution history has been reviewed in connection with the present application.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

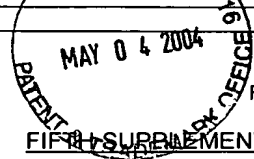
Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Grady L. Longworth
for Helene C. Carlson Reg. No. 47,756
Agent for Applicants
Registration No. 47,473

Date: May 4, 2004

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 <p>FORM PTO-1449</p> <p>FIFTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT</p>	<p>ATTY. DOCKET NO. 0942.4500004/BJD/HCC</p> <p>APPLICATION NO. 09/677,574</p> <p>FIRST NAMED INVENTOR Yang <i>et al.</i></p> <p>FILING DATE October 3, 2000</p> <p>ART UNIT 1652</p>

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
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	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

FOREIGN PATENT DOCUMENTS

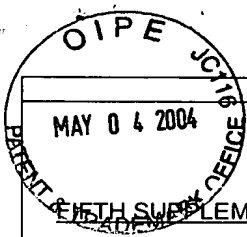
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR		
	AS	<u>51</u>	Copy of Office Action for United States Patent Application No. 08/576,759, Chatterjee, D.K., filed December 21, 1995, dated August 9, 1996
	AT	<u>51</u>	Copy of Office Action for United States Patent Application No. 08/576,759, Chatterjee, D.K., filed December 21, 1995, dated January 28, 1997

EXAMINER	DATE CONSIDERED
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.



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FIFTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

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	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

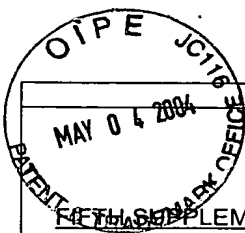
OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	<u>52</u>	Copy of Office Action for United States Patent Application No. 08/576,759, Chatterjee, D.K., filed December 21, 1995, dated July 9, 1999
AS	<u>52</u>	Copy of Office Action for United States Patent Application No. 08/576,759, Chatterjee, D.K., filed December 21, 1995, dated October 26, 1999
AT	<u>52</u>	Copy of Office Action for United States Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000, dated September 20, 2000

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1652FIFTH SUPPLEMENTAL INFORMATION DISCLOSURE
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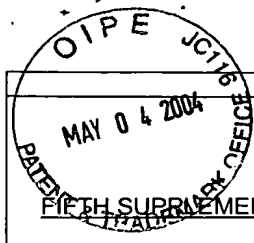
OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>53</u>	Copy of Office Action for United States Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000, dated June 4, 2001
	AS	<u>53</u>	Copy of Final Office Action for United States Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000, dated June 4, 2002
	AT	<u>53</u>	Copy of Office Action for United States Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000, dated July 26, 2002

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	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>54</u>	Copy of Office Action for United States Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000, dated April 22, 2003
	AS	<u>54</u>	Copy of Office Action for United States Patent Application No. 09/558,421, Chatterjee, D.K., filed April 26, 2000, February 9, 2004
	AT		

EXAMINER

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